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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,631	03/16/2001	Jung-wan Ko	1293.1184	5024

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EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,631

Applicant(s)

KO ET AL.

Examiner

John W Hayes

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10,15,18-25 and 42-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10,15,18-25 and 42-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/04;7/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 3621

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 June 2004 has been entered.

Status of Claims

2. Applicant has amended claims 7, 9-10, 18-19, 21-22 and 42, added new claims 43-49 and canceled claims 1-6, 11-14, 16-17 and 26-41 in the amendment filed 21 June 2004. Thus, claims 7-10, 15, 18-25 and 42-49 are the only claims that remain pending.

Response to Arguments

3. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 indicates that existing commodity catalog information is written in both the read-only area as well as the write once area of the medium. Examiner believes applicant meant

Art Unit: 3621

to recite that updated commodity catalog information is written in a write once area of the medium.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyama et al, JP07295998 (English translation) in view of Mortimer et al, U.S. Patent No. 6,091,930.

As per Claims 7-8, Toyama et al disclose a method of updating commodity catalog information recorded on a medium using a recording/reproducing apparatus, the method comprising:

- if the medium is mounted in the apparatus, accessing a server corresponding to the commodity catalog information written on the medium through a computer network (Paragraph 0009; 0034);
- if a link is set up with the corresponding server, checking whether there is a commodity item to be updated/edited in the commodity catalog information written on a predetermined read-only area of the medium (Paragraph 0009; 0034);
- if there is a commodity item to be updated/edited, transmitting the corresponding commodity catalog information from the server to the apparatus (0009; 0034; 0036);
- writing the transmitted commodity catalog information on a rewriteable area of the medium (0003; 0008; 0016; 0036);

Art Unit: 3621

- displaying the commodity catalog information recorded on the rewriteable area of the medium for retrieval after said writing the transmitted commodity catalog information (0024; 0025; 0034).

Toyama et al further disclose distinguishing the original goods data from the modified data (0032-0034 and 0045-0048), however, fails to specifically disclose marking the updated portion and the non-updated portion so that they are distinguishable from one another. Mortimer et al disclose a customizable interactive textbook stored on a CD-ROM (Abstract; Col. 9, lines 35-50; Col. 11, lines 10-18) wherein data added or altered is visually distinguishable from the original data using highlights, different fonts and underlines (Col. 16, lines 55-65). Mortimer et al further discloses distinguishing new or altered material from the old material using markers (Col. 17, lines 1-18). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Toyama et al and include an ability to distinguish original data from added or altered data using markers such as highlighting which uses different colors, different fonts or underlining as taught by Mortimer et al. Mortimer et al provides motivation by indicating that this would enable the reader to distinguish the original data from the added or altered data (Col. 16, lines 60-65 and Col. 17, lines 1-15).

As per **Claim 9**, Toyama et al further disclose recording a purchase order based on the retrieval of the commodity catalog information from the medium (0030; 0035; 0058).

As per **Claim 10**, Toyama et al further disclose wherein said checking whether there is a commodity item to be updated/edited is performed through communication with the commodity information server (Paragraph 0009; 0034).

8. Claims 15, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyama et al, JP07295998 in view of Tognazzini, EP 0817181 A2.

As per **Claim 15**, Toyama et al disclose a recording/reproducing medium comprising:

Art Unit: 3621

- a read-only area in which original commodity catalog information is written (Abstract; 0008; 0012);
- a writeable area in which updated commodity catalog information is written when provided by a server (0008; 0009);

Toyama et al, however, fail to disclose wherein the writeable area comprises an area to which information is written once, and is thereafter a read only area. Tognazzini disclose a hybrid optical disk recording medium having a read-only portion for storing information and a read/write area for reading, writing and erasing change data (Col. 2, lines 32-42) and further discloses that the read/write area could be used to store updates to a reference CD-ROM where original information could be pre-recorded on the read-only part and then periodically updated with the supplemental information stored in the read/write part (Col. 6, lines 6-13). Tognazzini discloses a read/write area for updated information, however, fails to specifically disclose that the read/write area is used as a write only once area which is thereafter a read-only area, however, examiner submits that this would have been obvious in view of applicant's own admission that CD-R and DVD-R formats are well known in the art (See applicant's specification, page 7, paragraph 0028). In other words, the CD-R format for compact disks wherein information is written once and is thereafter a read-only format was well known at the time of applicant's invention and it would have been obvious to create a hybrid optical disk such as that of Tognazzini having a read-only portion and a write-once portion in order to provide the ability to store read only information in the read only portion of the disk as well as writing information once in the write-once area of an optical disk. The motivation would be to provide the capability to record original information in the read-only portion as well as provide the capability to update the data once in the write-once portion as taught by Tognazzini. Tognazzini provides further motivation by indicating that this would alleviate the problem that original information cannot be changed and additional information cannot be easily written to a read-only optical disk after original information has been recorded in a manufacturing process (Col. 1, lines 20-25).

Art Unit: 3621

As per Claim 18, Toyama et al disclose a method of purchasing from and updating commodity catalog information recorded on a medium comprising:

- accessing a server corresponding to existing commodity catalog information read from the medium (Abstract; 0008; 0009);
- receiving updated commodity catalog information from the server (0009);
- writing the received updated commodity catalog information in a writeable area of the medium (0008; 0009);
- wherein the existing commodity catalog information is written in a read-only area of the medium (0008);
- wherein the updated commodity catalog information is written in a writeable area of the medium (0008; 0014).

Toyama et al, however, fail to disclose wherein the writeable area comprises an area to which information is written once, and is thereafter a read only area. Tognazzini disclose a hybrid optical disk recording medium having a read-only portion for storing information and a read/write area for reading, writing and erasing change data (Col. 2, lines 32-42) and further discloses that the read/write area could be used to store updates to a reference CD-ROM where original information could be pre-recorded on the read-only part and then periodically updated with the supplemental information stored in the read/write part (Col. 6, lines 6-13). Tognazzini discloses a read/write area for updated information, however, fails to specifically disclose that the read/write area is used as a write only once area which is thereafter a read-only area, however, examiner submits that this would have been obvious in view of applicant's own admission that CD-R and DVD-R formats are well known in the art (See applicant's specification, page 7, paragraph 0028). In other words, the CD-R format for compact disks wherein information is written once and is thereafter a read-only format was well known at the time of applicant's invention and it would have been obvious to create a hybrid optical disk such as that of Tognazzini having a read-only portion and a write-once portion in order to provide the ability to store read only information in the read only portion of the disk as well as writing information once in the write-once area of an optical disk. The motivation would be to provide the capability to record original information in the

Art Unit: 3621

read-only portion as well as provide the capability to update the data once in the write-once portion as taught by Tognazzini. Tognazzini provides further motivation by indicating that this would alleviate the problem that original information cannot be changed and additional information cannot be easily written to a read-only optical disk after original information has been recorded in a manufacturing process (Col. 1, lines 20-25).

As per Claim 22, Toyama et al further disclose making a purchase of a commodity using the existing and/or updated commodity catalog information (0030; 0035; 0058).

9. Claims 19-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyama et al, JP07295998 and Tognazzini, EP 0817181 A2 as applied above, and further in view of Uranaka, U.S. Patent No. 5,937,158.

As per Claims 19-20, Toyama et al and Tognazzini fail to disclose comparing ages of the existing information read from the medium and the updated information from the server and receiving the updated commodity catalog information where the ages are different. Uranaka discloses a system for connecting a portable media with a network, storing restaurant guide information on a DVD portable read-only medium and comparing the age of this information with the age of the information stored in the server and receives the updated information where the ages are different (Col. 10, lines 12-26). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Toyama et al and compare the ages of the existing data and the updated data as taught by Uranaka in order to determine if the update to the medium is necessary.

As per Claim 23, Toyama et al fail to disclose receiving a purchase record from the server after making the purchase and writing the purchase record to the writeable area of the medium. Uranaka discloses a catalog shopping system using a rewritable DVD having a portion for writing purchase history information for the user (Col. 17, lines 25-37). It would have been

Art Unit: 3621

obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Toyama et al and further write user's purchase history information on the medium so that the user can reference this information when making further purchases.

10. Claims 21 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyama et al, JP07295998 in view of Uranaka, U.S. Patent No. 5,937,158.

As per **Claim 21**, Toyama et al disclose a method of purchasing from and updating commodity catalog information recorded on a medium comprising:

- accessing a server corresponding to existing commodity catalog information read from the medium (Abstract; 0008; 0009);
- receiving updated commodity catalog information from the server (0009);
- writing the received updated commodity catalog information in a writeable area of the medium (0008; 0009);
- displaying both the existing and updated commodity catalog information such that the updated commodity catalog information is distinguishable from the existing commodity catalog information (0032-0034 and 0045-0048);
- wherein the existing commodity catalog information is written in a read-only area of the medium (0008);
- wherein the updated commodity catalog information is written in a writeable area of the medium (0008; 0014).

Toyama et al fail to disclose comparing ages of the existing information read from the medium and the updated information from the server and receiving the updated commodity catalog information where the ages are different. Uranaka discloses a system for connecting a portable media with a network, storing restaurant guide information on a DVD portable read-only medium and comparing the age of this information with the age of the information stored in the server and receives the updated information where the ages are different (Col. 10, lines 12-26). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to

Art Unit: 3621

modify the method of Toyama et al and compare the ages of the existing data and the updated data as taught by Uranaka in order to determine if the update to the medium is necessary.

As per Claim 24, Toyama et al further disclose making a purchase of a commodity using the existing and/or updated commodity catalog information (0030; 0035; 0058).

As per Claim 25, Toyama et al fail to disclose receiving a purchase record from the server after making the purchase and writing the purchase record to the writeable area of the medium. Uranaka discloses a catalog shopping system using a rewritable DVD having a portion for writing purchase history information for the user (Col. 17, lines 25-37). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Toyama et al and further write user's purchase history information on the medium so that the user can reference this information when making further purchases.

11. Claims 42-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyama et al, JP 07295998 in view of Yoshimoto et al, U.S. Patent No. 5,953,309.

As per Claims 42, 45 and 48, Toyama et al disclose a recording/reproducing medium comprising:

- a read only area in which original commodity catalog information is written ((Abstract; 0008; 0012);
- a optically writeable area in which updated commodity catalog information is written when provided by a server (0008; 0009).

Toyama et al, however, fail to disclose wherein the writeable area comprises a write once areas and a rewriteable area to which data can be repeatedly written and/or from which data can be erased. Yoshimoto et al disclose an optical disk having multiple zones wherein each zone may be a rewritable area which may be written, erased and rewritten many times, a write-once area or a read-only area and this can be independently set for each zone (Col. 4, lines 20-26). It

Art Unit: 3621

would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Toyama et al and utilize a recording medium having a read-only portion, a write-once portion and a rewritable portion as taught by Yoshimoto et al. Yoshimoto et al provides motivation by indicating that this would enable a user to place different types of areas in a single disk which would best suit the intended application (Col. 4, lines 20-25).

As per **Claim 43**, Toyama et al further disclose a first area in which the original commodity catalog information as of a manufacture time of the medium is written (0008; 0009), however, fails to disclose a second area in which an encrypted key of a vendor is written. Yoshimoto et al disclose an optical disk having a multiplicity of zones wherein each zone may be a rewritable area, a write-once area or a read-only area and this can be independently set for each zone (Figure 20; Col. 4, lines 20-26). Yoshimoto et al also fail to specifically disclose writing an encrypted key of a vendor in the second area, however, the specific type of data being stored is deemed to be merely non-functional descriptive material and is not functionally involved in the steps recited. The step of storing or writing any type of data would be performed the same regardless of the descriptive material since none of the steps explicitly interact therewith. Limitations that are not functionally interrelated with the useful acts, structure, or properties of the claimed invention carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to store or write any type of data in the recording medium because such data does not functionally relate to the structure claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per **Claims 44 and 46-47**, Toyama et al further disclose an area in which updated commodity catalog information is written (0008; 0009), however, fails to disclose separate areas

Art Unit: 3621

in which an update date, commodity purchase information and user's private information is written. Yoshimoto et al disclose an optical disk having a multiplicity of zones wherein each zone may be a rewritable area which may be written, erased and rewritten many times, a write-once area or a read-only area and this can be independently set for each zone (Figure 20; Col. 4, lines 20-26). Yoshimoto et al also fail to specifically disclose writing update date, purchase information and a user's private information, however, the specific types of data being stored is deemed to be merely non-functional descriptive material and is not functionally involved in the steps recited. The step of storing or writing any type of data would be performed the same regardless of the descriptive material since none of the steps explicitly interact therewith. Limitations that are not functionally interrelated with the useful acts, structure, or properties of the claimed invention carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to store or write any type of data in the recording medium because such data does not functionally relate to the structure claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per **Claim 49**, Toyama et al and Yoshimoto et al fail to specifically disclose that the writeable area comprises an area to which information is magnetically written. However, examiner takes official notice that magnetic mediums such as floppy disks and hard disks are well known in the art and it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use magnetic medium in lieu of optical mediums depending upon the desires of the user.

Art Unit: 3621

Conclusion

12. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Art Unit: 3621

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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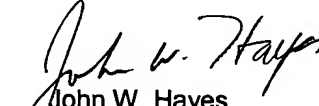
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John W. Hayes
Primary Examiner
Art Unit 3621

August 13, 2004